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Verizon Services Corp.; and
Verizon Business Network Services LLC

**UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA**

VOIP-PAL.COM, INC.,

Plaintiff,

v.

CELLCO PARTNERSHIP d/b/a Verizon
Wireless,

Defendant.

CELLCO PARTNERSHIP d/b/a/ Verizon
Wireless,

Plaintiff,

v.

VOIP-PAL.COM, INC.,

Defendant.

Case No. 5:18-cv-06054-LHK

**STATEMENT IN SUPPORT OF *SUA*
SPONTE JUDICIAL REFERRAL FOR
PURPOSE OF DETERMINING
RELATIONSHIP**

Case No. 5:20-cv-03092-LHK

**STATEMENT IN SUPPORT OF *SUA*
SPONTE JUDICIAL REFERRAL FOR
PURPOSE OF DETERMINING
RELATIONSHIP**

1 CELLCO PARTNERSHIP d/b/a Verizon
2 Wireless;
3 VERIZON SERVICES CORP.; and
4 VERIZON BUSINESS NETWORK SERVICES
5 LLC,

6 Plaintiff,

7 v.

8 VOIP-PAL.COM, INC.,

9 Defendant.

Case No. 5:21-cv-05275-BLF

**STATEMENT IN SUPPORT OF *SUA*
SPONTE JUDICIAL REFERRAL FOR
PURPOSE OF DETERMINING
RELATIONSHIP**

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I. INTRODUCTION

Pursuant to the Northern District of California’s Civil Local Rules 3-12(b) and 7-11, Case No. 5:21-cv-05275-BLF (the “2021 Verizon DJ Action”) should be related to *Cellco Partnership d/b/a Verizon Wireless v. Voip-Pal.com, Inc.*, Case No. 5:20-cv-03092-LHK (the “2020 Verizon DJ Action”) and *Voip-Pal.com, Inc. v. Verizon Wireless Services LLC et al.*, Case No. 5:18-cv-06054-LHK (the “2016 VoIP-Pal Action”). The 2021 Verizon DJ Action should also be related to recently-filed actions captioned *Apple Inc. v. VoIP-Pal.com, Inc.*, Case No. 5:21-cv-05110, *AT&T Corp. et al v. VoIP-Pal.com, Inc.*, Case No. 3:21-cv-05078, *Twitter, Inc. v. VoIP-Pal.com, Inc.*, Case No. 5:21-cv-02769-LHK, *AT&T Corp. et al v. VoIP-Pal.com, Inc.*, Case No. 5:20-cv-02995-LHK, *Apple Inc v. Voip-Pal.com, Inc.*, Case No. 5:20-cv-02460-LHK, and *Twitter, Inc. v. Voip-Pal.com, Inc.*, Case No. 5:20-cv-02397-LHK (collectively the “VoIP-Pal DJ Actions”). The VoIP-Pal DJ Actions filed in 2020, the 2020 Verizon DJ Action, and the 2016 VoIP-Pal Action are before the Honorable Lucy H. Koh.

By this statement, Verizon supports Judge Labson Freeman’s *sua sponte* judicial referral and respectfully requests an order relating the 2021 Verizon DJ Action to the above-captioned 2020 Verizon DJ Action, the 2016 VoIP-Pal Action, and VoIP-Pal DJ Actions. The requested order will allow one court to preside over all VoIP-Pal disputes, which concern the same parties, the same technology, similar patents, and overlapping accused products.

II. DISCUSSION

A. **Factual Background**

The 2016 VoIP-Pal Action was originally filed in Nevada, but VoIP-Pal consented to transfer to this Court after a fully-briefed motion to transfer. 2016 VoIP-Pal Action, Dkt. No. 89. Judge Koh presided over the 2016 VoIP-Pal Action and five other lawsuits filed by VoIP-Pal, which the Court deemed related to each other: Verizon (Case No. 5:18-cv-06054-LHK); AT&T (Case No. 5:18-cv-06177-LHK); Apple (Case No. 5:18-cv-06217-LHK); Twitter (Case No. 5:18-cv-04523-LHK); Apple (Case No. 5:18-cv-06216-LHK); and Amazon (Case No. 5:18-cv-07020-LHK). In those cases, VoIP-Pal asserted six patents: U.S. Patent Nos. 8,542,815; 9,179,005; 9,537,762; 9,813,330; 9,826,002; and 9,948,549 (which VoIP-Pal refers to collectively as the

“RBR patents” or the “previously asserted patents”). The six patents share a common specification. VoIP-Pal described them as addressing the same advancements or improvements to IP communications. *Compare* Case No. 5:18-cv-06054-LHK, Dkt. No. 119 at 3, *with* Case No. 5:18-cv-06216-LHK, Dkt. No. 65 at 4. In each of those cases, the defendants filed consolidated motions to dismiss arguing the asserted patents were invalid under 35 U.S.C. § 101 for claiming patent ineligible subject matter, which the Court granted. *E.g.*, Case No. 5:18-cv-04523-LHK, Dkt. Nos. 82, 84; Case No. 5:18-cv-06216-LHK, Dkt. Nos. 114, 115. The Federal Circuit affirmed. *VoIP-Pal.com, Inc. v. Twitter, Inc.*, No. 2019-1808, slip op. (Fed. Cir. Mar. 16, 2020); *VoIP-Pal.com, Inc. v. Apple, Inc.*, No. 2020-1241, slip op. (Fed. Cir. Nov. 3, 2020).

Despite having told this Court in November 2018, that it did not intend to file any additional claims against Verizon and its co-defendants, VoIP-Pal attempted to expand its patent litigation campaign against Verizon and others in 2020—this time filing in the Western District of Texas. 2020 Verizon DJ Action, Dkt. No. 35-4 at 10. VoIP-Pal filed six new lawsuits against many of the same defendants, including Verizon and AT&T, in the Western District of Texas (the “2020 Texas lawsuits”). In the 2020 Texas lawsuits, VoIP-Pal asserted U.S. Patent No. 10,218,606, which is in the same family as, and shares the same specification with, the six patents asserted in the earlier cases.

VoIP-Pal’s 2020 Texas lawsuits were improper forum shopping—a clear attempt to avoid this Court and the experience and knowledge that Judge Koh specifically had gained through its prior decisions on highly-related subject matter. (*See* 2020 Verizon DJ Action, Dkt. 8, 8-1.) As a result, AT&T, Verizon, Apple, and Twitter each filed declaratory judgment actions against VoIP-Pal in this District, seeking a declaration of non-infringement and invalidity for the same patent at issue in the 2020 Texas lawsuits: Verizon (Case No. 5:20-cv-03092-LHK); Apple (Case No. 5:20-cv-02460-LHK); Twitter (Case No. 5:20-cv-02397-LHK); and AT&T (Case No. 5:20-cv-02995-LHK) (collectively the “2020 DJ Actions”).

The Court deemed these 2020 DJ Actions related to each other and to the earlier VoIP-Pal cases in this District and denied VoIP-Pal’s motion to dismiss under the first-to-file rule. 2020 Verizon DJ Action, Dkt Nos. 18, 19; Dkt. 54 at 9-14. Thereafter, the 2020 Texas case against

Verizon was dismissed without prejudice. Case No. 6:20-cv-00327-ADA, Dkt. No. 49. The Court also analyzed VoIP-Pal's arguments regarding lack of personal jurisdiction over it for the 2020 DJ Actions.

VoIP-Pal, once again flying in the face of its 2018 representations, now has filed yet another set of new complaints against many of the same parties, including Verizon, in the Western District of Texas, asserting another two patents—U.S. Patent Nos. 8,630,234 (the "'234 patent") and 10,880,721 (the "'721 patent") (VoIP-Pal refers to these patents as the "Mobile Gateway patents" or the "'234 and '721 patents"). There are several reasons the '234 and '721 patents are similar to VoIP-Pal's previously-asserted patents.

First, the '234 and '721 patents and the previously asserted patents were originally assigned to Digifonica (International) Limited (just like the eight patents at issue in the earlier cases), and the '234 and '721 patents share an inventor (Johan Emil Viktor Björsell) with all of VoIP-Pal's previously asserted patents.

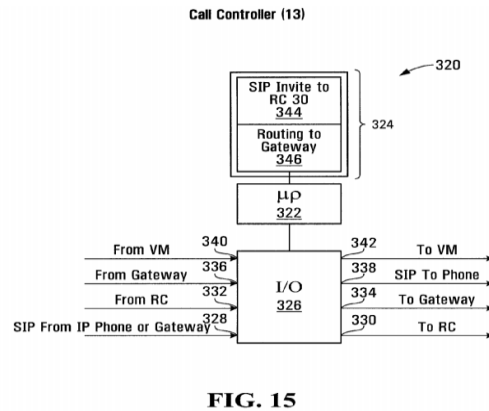
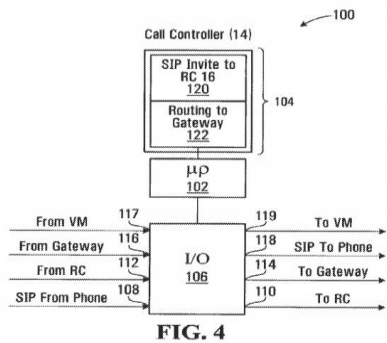
Second, the '234 and '721 patents and the previously asserted patents relate to the same subject matter: call routing functionality based on callee identifiers. Indeed, the Abstracts demonstrate the similar subject matter:

- '606 patent, Abstract: "A process and apparatus to facilitate communication between callers and callees. . . . In response to initiation of a call by a calling subscriber, a caller identifier and a callee identifier are received[.]" 2020 Verizon DJ Action, Dkt. No. 1-1 (the "'606 patent").

- '234 and '721 patent, Abstracts: "A method of initiating a call to a callee using a mobile telephone. . . receiving, from a user of the mobile telephone, a callee identifier associated with the callee." 2021 Verizon DJ Action, Dkt. Nos. 1-1, 1-2.

There are other, notable similarities between the '234 and '721 patents and the previously asserted patents. For example, each contains claim language referring to a particular "identifier." '606 patent, claim 1 ("a second participant identifier associated with the second participant device"); '234 patent, claim 1 ("callee identifier associated with said location identifier"); '721

patent, claim 1 (“a destination node identifier associated with the destination node”). And the figures of the patents are the same or similar:



The above examples each describe the same “call controller” as seen in figure 4 of the previously asserted patents and figures 15 of the ’234 and ’721 patents. Other examples include figure 2 from each patent describing a “phone” and in particular its “memory” structure including a “Parameter Memory,” “Program Memory,” and “Temporary Memory;” figure 9 from each patent describing the “Dialing Profile for a User;” figure 3 of the ’606 patent and figures 14 of the ’234 and ’721 patents depicting a “SIP Invite Message;” figure 6 of the ’606 patent and figures 17 of the ’234 and ’721 patents describing a “RC Request Message;” figures 8A-8B of the ’606 patent and figures 18A-18B of the ’234 and ’721 patents showing flowcharts for an “RC Request Message Handler.”

As further evidence of the overlap, VoIP-Pal cited hundreds of documents related to the previously asserted patents during prosecution of the ’721 patent, including litigation filings from VoIP-Pal litigations before Judge Koh, invalidity contentions references from VoIP-Pal’s prior litigations before Judge Koh, and docket filings from *inter partes* reviews of some of the previously asserted patents.

Third, VoIP-Pal admits that its technology—including the previously asserted patents and the ’234 and ’721 patents—generally relates to “improvements to communications technology” that “facilitate communications across and between internet-protocol-based communication systems and other networks, such as internally controlled systems and external networks (e.g., across private networks and between private networks and public networks), including providing

access to and routing through internet-protocol-based communication systems.” 2021 Verizon DJ Action, Dkt. No. 1-9 at 5. VoIP-Pal has previously stated that the previously asserted patents relate to “methods, processes and apparatuses that facilitate communications across and between internet protocol based communication systems and networks, such as internally controlled systems and external networks (e.g., across private networks and between private networks and public networks), including the classification and routing thereof.” Case No. 6:20-cv-327-ADA, Dkt. 1 at ¶ 15 (Complaint).

Finally, VoIP-Pal has accused the same Verizon products and services of infringement in each of the previously asserted patents and the ’234 and ’721 patents cases: Wi-Fi Calling (or VoWiFi).

Forced to defend against VoIP-Pal’s piecemeal litigation and forum shopping again, Verizon filed the 2021 Verizon DJ Action asserting non-infringement and invalidity of the ’234 and ’721 patents that VoIP-Pal asserted in its 2021 Texas case. In the 2021 Texas case, VoIP-Pal has filed a motion for temporary restraining order and preliminary injunction to prevent Verizon, AT&T, and Apple from pursuing the 2021 declaratory judgment actions. Case No. 6:21-cv-00672, Dkt. No. 18.

B. The Actions Are Related Cases

The Verizon 2021 DJ Action and the above-captioned 2020 Verizon DJ Action are related cases under Civil L.R. 3-12(a).

1. Civil. L.R. 3-12(a)(1)

First, under Civil. L.R. 3-12(a)(1) the two actions concern overlapping parties—VoIP-Pal and Cellco Partnership d/b/a Verizon Wireless. The cases relate to substantially the same property: VoIP-Pal’s patent portfolio, in particular the ’234 and ’721 patents. As detailed above in Section II.A, the ’234 and ’721 patents are very similar to the patents at issue in the 2020 DJ Actions (including the 2020 Verizon DJ Action) and 2016 VoIP-Pal Action. VoIP-Pal strains to identify terms that appear in the ’234 and ’721 patents but not in the previously asserted patents and vice versa (Dkt. No. 76 at 4-5). But these are minor differences, and VoIP-Pal must concede that all of the patents are related to call routing functionality based on callee identifiers. The 2021 Verizon

DJ Action and the other cases concern substantially the same transaction or event: whether Verizon's Wi-Fi Calling (VoWiFi) service infringes VoIP-Pal's patents, and whether the '234 and '721 patents, which are similar to VoIP-Pal's other patents, are invalid.

VoIP-Pal urges that the relatedness of technology between the asserted patents is not sufficient, citing *NXP Semiconductors USA, Inc. v. LSI Corp.*, No. C-08-00775-JW, Dkt. No. 187 at 2 (N.D. Cal. Jan. 5, 2009). But there, the patents in the first case were owned by LSI and the patents in the second case were owned by NXP. Here, VoIP-Pal owns all of the patents at issue (although they were originally all assigned to Digifonica), all patents include a same inventor, and all patents are directed to call routing functionality based on identifying information about the callee.

2. Civil. L.R. 3-12(a)(2)

Given the facts set forth above, it would be an unduly burdensome duplication of labor and expense if the 2021 declaratory judgment action was conducted before Judge Labson Freeman instead of before Judge Koh. For example, Judge Koh has invested substantial time in analyzing and issuing substantive, dispositive rulings on the six patents that VoIP-Pal asserted in the 2018 and 2019 cases. Judge Koh is currently presiding over the 2020 DJ Actions between VoIP-Pal against Apple, AT&T, and Twitter. The '234 and '721 patents may stem from a different patent family, but as described above, they issued from the same company, have overlapping inventors, have overlapping claim terms, are directed to similar technology, and are asserted against the same Verizon Wi-Fi Calling services. In addition, VoIP-Pal will likely move to dismiss the 2021 Verizon DJ Action under the first-to-file rule and for lack of personal jurisdiction. VoIP-Pal filed the same motion in the 2020 Verizon DJ Action, and Judge Koh analyzed the facts and law issuing a detailed, 27-page opinion denying VoIP-Pal's motion to dismiss. 2020 Verizon DJ Action, Dkt. No. 54. Judge Labson Freeman does not have familiarity with any of the issues in the context of these disputes that Judge Koh has developed. There would be substantial duplication of effort and expense and risk of conflicting decisions (regarding, for example, claim construction, patent eligibility, and jurisdiction) if the 2021 Verizon DJ Action were not assigned to Judge Koh.

VoIP-Pal's reliance on *Karamelion LLC v. Nortek Security & Control, LLC*, is misplaced because unlike here, the "Court did [not] consider or rule on any substantive motions in *Karamelion I.*" Case No. 4:19-cv-06016-YGR, Dkt. No. 21 at 2 (N.D. Cal. Jan 14, 2020). *Uniloc USA, Inc. v. Logitech, Inc.* and *Hynix Semiconductor, Inc. v. Rambus, Inc.* are also distinguishable because in those cases, unlike here, there was no overlap between the parties. *Uniloc USA, Inc. v. Logitech, Inc.*, No. 18-CV-01304-LHK, 2018 U.S. Dist. LEXIS 208122, at *4 (N.D. Cal. Dec. 5, 2018) ("there is no overlap between the instant case and the defendants, patents, inventors, and technology standards"); *Hynix Semiconductor, Inc. v. Rambus, Inc.*, No. C-00-20905 RMW, 2008 U.S. Dist. LEXIS 68625, at *14-15 (N.D. Cal. Aug. 24, 2008) (the new case against NVIDIA does not concern "the same parties, property, transaction or event," because NVIDIA was not a party to the prior cases).

C. VoIP-Pal, not Verizon, is Forum Shopping

VoIP-Pal's allegations that Verizon is forum shopping are unfounded. Like the Verizon 2020 DJ Action, "it would be far less efficient for the Western District of Texas to resolve these cases based on the Northern District of California's familiarity with the overlapping issues." *In re Voip-Pal.Com, Inc.*, 845 F. App'x 940, 942 (Fed. Cir. 2021). VoIP-Pal's recently established "virtual office" in Waco is an attempt to manipulate venue and should be disregarded. *In re Samsung Electronics Co.*, No. 21-139, Dkt. 33 at 10 ("the Supreme Court and this court have repeatedly assessed the propriety of venue by disregarding manipulative activities of the parties.") VoIP-Pal "stipulate[ed] to transfer [of] five lawsuits" to this District, and this Court gained familiarity with the parties, the technology, similar patents, and overlapping accused products as a result of that transfer. *Apple Inc. v. VoIP-Pal.com, Inc.*, No. 20-CV-02460-LHK, 2020 U.S. Dist. LEXIS 233613, at *27 (N.D. Cal. Dec. 11, 2020).

For the foregoing reasons, having Judge Koh preside over the 2021 declaratory judgment action would conserve judicial resources and promote the efficient resolution of the action.

III. CONCLUSION

Verizon supports Judge Labson Freeman's *sua sponte* judicial referral and respectfully requests a determination that the 2021 Verizon DJ Action (Case No. 5:21-cv-05275) is related to

the 2020 Verizon DJ Action, the 2016 VoIP-Pal Action, and VoIP-Pal DJ Actions. The 2021 Verizon DJ Action should thus be assigned to the Honorable Lucy H. Koh.

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